

REMARKS / ARGUMENTS

The Applicants thank the Office for the careful consideration given to their application in the communication mailed 02/05/2009. In that communication, claims 1 – 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over a York Flashing web reference in view of Healy et al. (US 3,654,765). Claims 21 – 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sourlis (US 6,023,892) in view of York Flashing and Healey et al.

The Applicants, however, object to their application being subjected to a *third* substantive examination and again being subjected to new grounds of rejection. Under 37 CFR 1.104(b) and MPEP 707.07, the rule is that “[t]he examiner's action will be complete as to all matters...” The present case has been subjected to substantive examinations on 10/19/2007, 08/07/2008, and 02/05/2009. The Applicants have responded to the satisfaction of the Office the first two times, as admitted in the Office's Response to Arguments in its immediately following communications. This application should not be subjected to more 103(a) rejections. It appears that the examiner's actions were not complete as to all matters. Furthermore, the Applicants have previously provided several declarations traversing rejection that show that the present invention is not obvious by providing secondary considerations of unobviousness. Also, three of the four independent claims (1, 21, and 24) have **not** been amended during prosecution, so nothing the Applicants have done has necessitated further searching or examination of those claims. Claim 17 was amended to narrow it, and not to shift claim scope. Therefore, the Applicants respectfully request reconsideration or withdrawal of the rejections communicated on 02/05/2009.

In the alternative, the Applicants respond to the 103(a) rejection of claims 1 – 20 and 21 to 24 as follows. The Office appears to improperly take official notice by holding that, “[i]t is well known in the through-wall flashing art to including wicking material on top of a flashing member...” in its Office action,

paragraphs 6, 10, 13, and 16. The Applicants assert that it is **not** well known, and the addition of wicking material is a novel and unobvious feature of the present invention. Regarding taking official notice, the MPEP states as follows:

It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience-or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings."). While the court explained that, "as an administrative tribunal the Board clearly has expertise in the subject matter over which it exercises jurisdiction," it made clear that such "expertise may provide sufficient support for conclusions [only] as to peripheral issues." Id. at 1385-86, 59 USPQ2d at 1697. As the court held in Zurko, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. Id. at 1385, 59 USPQ2d at 1697.

MPEP 2144.03 A. In the present application, the addition of wicking material is not a peripheral issue. It is a central issue to patentability. Declaration of Lincourt, 09/05/08, paragraph 10.

The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See Soli, 317 F.2d at 946, 37 USPQ at 801; Chevenard, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice so as to adequately traverse the rejection in the next reply after the Office action in which the common knowledge statement was made.

MPEP 2144.03 B. The Office has not presented any explicit basis for his official notice of well known material. Therefore, the Applicants respectfully request that the Office produce authority for the statement that, “[i]t is well known in the through-wall flashing art to including wicking material on top of a flashing member...” If no authority exists, the Applicants respectfully request that the Office provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. MPEP 2144.03 C.

When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

37 CFR 1.104(d)(2).

Next, the Office asserts that Healy et al. teaches the methodology of including wicking material on top of a flashing member in order to prevent debris from blocking the patch of moisture. The Applicants wish to point out that the terms “wick” or “wicking” do not appear anywhere in Healy and therefore Healy cannot teach that methodology. Healy teaches filtering, not wicking. This is a significant difference, which is now supported another Declaration Traversing Rejection by Lincourt. The Declaration also includes a dictionary definition of “wick” which is consistent with how the term is used in the present application.

None of the cited references teach the inclusion of a wicking cloth, which is an element of each of the four independent claims. Therefore, the Office has not made a prima facie case of obviousness that the Applicants are required to rebut.

The Applicants point out that four Declarations Traversing Rejection are

already of record in this case. The Declarations were all submitted by disinterested experts and show secondary considerations of unobviousness. They are incorporated by reference into this Office action response.

The above arguments are directed to the four independent claims, which the Applicants assert are allowable. The dependent claims add limitations or additional elements to those claims. 35 USC 112, fourth paragraph. Therefore, the dependent claims should be allowable if their independent claims are allowable.

For the foregoing reasons, the Applicants suggest that all the pending claims are allowable, and respectfully requests that a Notice of Allowance be issued in this case.

Respectfully submitted,

/Phillip E. Decker/

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Tel. No. 603-766-1910
Fax No. 603-766-1901

Phillip E. Decker, Reg. No. 39,163
Attorney for Applicant
1 New Hampshire Ave., Suite 125
Portsmouth, NH 03801